

The opinion in support of the decision being entered  
today was not written for publication and  
is not binding precedent of the Board

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

AUG 20 2003

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte Anthony J. Konechi and  
Girish A. Dixit

Appeal No. 2003-1768  
Application No. 08/988,686

REMAND

Before TIMM, PAWLIKOWSKI, and POTEATE, Administrative Patent  
Judges.

PAWLIKOWSKI, Administrative Patent Judge.

REMAND TO THE EXAMINER

This is an appeal from the examiner's refusal to allow  
claims 21-32.

Claims 21-26, 29, and 30 stand rejected under 35 U.S.C.  
§ 103 over Japanese Patent document No. 04-171744 (Masanori).  
Claims 27, 28, 31, and 32 stand rejected under 35 U.S.C.  
§ 103 over Japanese Patent document No. 04-171744 (Masanori) in  
view of Takeyasu, and further in view of Pan.

We observe that the examiner relies upon the Japanese  
foreign reference of Masanori. The examiner cites to Figure 2  
and page 280 of the Japanese document, and the abstract on page 7  
of the Answer. However, not until Paper No 28 (dated November

19, 2002); is it indicated in the record that an English translation is provided. This is after the filing date of appellants' Reply Brief (September 4, 2002). We note that a Request Form for Translation is in the file, showing that a translation was made, but no document is attached thereto, and appellants indicate that no English translation was provided.

(Reply Brief, page 2.)

Therefore, we request that the examiner verify that the appellants received the translation and obtain a copy for the file wrapper. If appellants do not have a copy of the translation, a new translation should be obtained, with one copy placed in the file and another copy sent to appellants.

We further note that the record does not indicate (1) that the examiner reviewed the full translation and (2) that appellants were given the opportunity to respond to the contents of a full translation. We note that abstracts, at best, are only short summaries of what is contained in the full document and their conciseness can distort what is taught in the full document. Here, we lack the views of the examiner and appellants, those most knowledgeable of the technology and prosecution, with regard to the critical evidence (full translation). Hence, we do not have a proper basis for our review at this point in time. See Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001).

We therefore remand this application to the examiner for consideration of the abovementioned issues. If reliance upon the English translation in any way constitutes a new ground of rejection, we authorize the examiner to reopen prosecution of the application. Otherwise, we authorize the examiner to file a Supplemental Examiner's Answer.

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This application, by virtue of its "Special" status requires an immediate action, Manual of Patent Examining Procedures § 708.01(d), 8<sup>th</sup> Edition (Rev. 1, February, 2003).

It is important that the Board be promptly informed of any action (abandonment, reopening prosecution, etc.) affecting the appeal in this application.

REMANDED

*Catherine Timm*

Catherine Timm )  
Administrative Patent Judge )  
)

*Beverly A. Pawlikowski*

Beverly A. Pawlikowski ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
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*Linda R. Poteate*

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BAP/cam

Appeal No. 2003-1768  
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